



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,005	10/24/2003	John W. Forsberg	1023-294USD1	9349
28863 7590 10/01/2008 SHUMAKER & SIEFFERT, P. A. 1625 RADIO DRIVE SUITE 300 WOODBURY, MN 55125				
EXAMINER FLORY, CHRISTOPHER A				
ART UNIT		PAPER NUMBER		
3762				
NOTIFICATION DATE		DELIVERY MODE		
10/01/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pairedocketing@ssiplaw.com

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/693,005

Applicant(s)

FORSBERG ET AL.

Examiner

CHRISTOPHER A. FLORY

Art Unit

3762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 June 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s) _____.
13. ☐ Other: _____.

/George Manuel/
Primary Examiner, Art Unit 3762

Continuation of 5. Applicant's reply has overcome the following rejection(s): 1-12, 14-21 and 32 rejected under 102(b) based upon a public use or sale bar.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments regarding the rejection of claims 1-12, 14-21 and 32 under 35 U.S.C. §103(a) as obvious over Meadows'227 in view of the cited supporting documents have been considered but are not persuasive.

Applicant first argues that one would not look to modify an external device (e.g. a medical programmer) with teachings from a reference to an implanted medical device such as the one taught in Whitehurst. First, it is noted that RF and IR are both well-known and interchangeable communications means used in the medical art. It involves only routine skill in the art to choose an IR transmitter/receiver versus an RF transmitter/receiver to suit one's intended purpose. Secondly, it would be natural for one to look at the teachings of an internal device when considering improvements to an external programming device since the two are always used in concert, such that especially an improvement to the telemetry means of one would provide a corollary improvement to the communications means of the other. Further, it is considered that Meadows is capable of implantation and Whitehurst is capable of explanation without destroying functionality in either, such that the mere concept of implantable versus external should not serve as a barrier for one skilled in the art to seek teachings from one to consider improvements in the other, particularly in the instant case where both teachings are in the same problem solving area of improving a telemetry/communications system that necessarily involves components of and coordination between both devices.

Regarding Applicant's arguments directed towards the finite seeking period of the instant claim 1, it is noted that while the claims are considered in light of the specification, the specification is not read into the claims. Claim 1 does not positively and specifically recite a finite seeking period and most definitely does not recite a listening period, but simply requires that the controller "seek...for a finite period of time." Therefore, even in the instance when e.g. a communication session is established in Meadows, the seeking would necessarily end and be finite. The Examiner also maintains the position taken on the periods of time between communication sessions, given this broader reading of "seeking for a finite period of time" rather than clearly establishing a listening window.

Similarly, the language "in response to power-up" does not limit the activation to being immediately following or irreversibly and unavoidably resulting from the power-up of the programmer, but merely implies that the seeking happens after the power-up occurs. Therefore the original position taken by the Examiner is considered valid and is maintained. Additionally, the Applicant cites on page 11 an embodiment of Meadows where the infrared interface is actuated when a cable is connected between devices. This again does not preclude from reading on the language as currently written, since such a connection happens after the power-up. It is also maintained that the seeking and session itself must necessarily occur after or in response to power-up since e.g. plugging in the IR cable when the device is off will not do anything, and will only establish communication when it is connected after, i.e. in response to, power-up.

Regarding Applicant's arguments directed towards claim 2, it is noted that the language of the claim is unclear in that it does not sufficiently establish whether the limitation of "5 to 10 seconds following" is intended to convey that the seeking begins immediately following power-up and continues for 5 to 10 seconds, or if the seeking begins 5 to 10 seconds after power-up and continues for an unspecified amount of time. Regardless, it would have been obvious to one having ordinary skill in the art at the time of the invention to use a range of 5-10 seconds in either scenario, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges (In re Aller, 105 USPQ 233) or optimum value of a result effective variable (In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980)) involves only routine skill in the art.

Regarding Applicant's arguments towards claims 6 and 11, the Examiner maintains the positions and explanations set forth previously in the Final Rejection of 21 March 2008 and the Advisory Action of 23 August 2007.